



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/058,656	01/30/2002	Yoshihisa Tsukada	0649-0821P-SP	3874
2292	7590	03/25/2005	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			CHEA, THORL	
			ART UNIT	PAPER NUMBER
			1752	
DATE MAILED: 03/25/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/058,656

Applicant(s)

TSUKADA ET AL.

Examiner

Thorl Chea

Art Unit

1752

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3 and 5-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3 and 5-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1, 3, 5-21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claiming of the step of emulsion polymerizing one or more monomers to form the polymer latex with halogen content of not more than 500 ppm, wherein the polymer latex is not subjected to purification through a desalting step in claim 1 and in claim 19 as part of a method for preparing a heat developable material raises the issue of new matter since the specification as originally filed fails to disclose the step of forming polymer latex binder as part of the process for forming a heat developable material. See the process for synthesis of polymer latex on pages 29-32 and the process for forming the heat-developable material on pages 163- 171; pages 183-184 wherein the process for forming an image forming layer is not include a step for forming a polymer latex binder.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 1752

4. Claims 19-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 19 is indefinite for failing to provide a processing steps for preparing the heat-developable material. The “emulsion polymerizing one or more monomers” set forth in the claims is related to the process for forming the polymer latex rather than heat developable material. In the absence of providing a step as how to form the heat-developable material, the process as claimed is indefinite.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 3, 5-6, 18-21 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over EP0911691 (EP'691).

Art Unit: 1752

EP'691 discloses a process for forming a photothermographic material containing polymer latex which has been treated with a separation fractional polymer or has an ionic conductivity of up to 2,5 mS/cm. Note to the material on page 29 , claims 1-12. Since the polymer latex has been treated before the use thereof in the heat developable material, the material that would affect the property of the photothermographic material would be reduced. Note for instance on page 3 last paragraph, it is disclosed that "a polymer latex is treated with a separation functional polymer as by ultrafiltration is usually carried out plural time", and "is reduced ionic conductivity". The step of coating the forming emulsion layer on a support is disclosed on page 28, [0143]., and the step subjecting the polymer latex to purification using the ion-exchange resin and separation membrane is disclosed on page 3, [0015]; and the polymer latex obtained by polymerization of more than one monomers is shown on page 4, [0024] to [0027].

EP'691 discloses the process for forming a polymer latex that is not subjected to purification through a desalting step and the process of coating to the emulsion layer on the support as claimed, but may not disclose the amount of halogen content of not more than 500 ppm present in the claimed invention. However, the polymer taught in the EP'691 is not subjected to purification through a desalting step similar to that of the claimed invention. According, the amount of halogen would be inherent to purification process taught in EP'691. In the absence of showing otherwise, it is asserted that it asserted that the polymer latex taught in the EP'691 is more purified and the ionic group such as halogen ion would be reduced to very small amount included the halogen ion presented in the claimed invention, and the invention as claimed would be either anticipated or found obvious over EP'691 in the absence of showing otherwise.

Art Unit: 1752

8. Claims 7-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP0911691 (EP'691) as applied to claims 1-6 above, and further in view of Kato (US Patent No. 6,174,663), Harring et al (US Patent No. 5,637, 449) and EP0803764 (EP'764).

Kato discloses a compound having a phosphoryl group in its molecule and the amine derivative as high contrast accelerator (abstract, and column 11, lines 17-20); Harring in column 16, lines 51-68, and columns 17-18 disclosed hydrogen donor as contrast enhancing compound; Milton in column 2 discloses a phosphoryl compound as antifoggant for silver halide material; EP'764 on page 12 a phenolic reducing agent of formula (I) of claim 9, including the compound having a phosphoryl group its molecule as reducing agent. It would have been obvious to the worker of ordinary skill in the art at the time the invention was made to use a known reducing agent and the high contrast enhancer taught in Kao, Harring, Milton and EP'764 in the material of EP'691 with an expectation of achieving a material producing low fog, stable during storage and high image contrast.

9. Claims 1, 3, 5-21 are rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over EP 1096310 (EP'310).

EP'310 discloses a process for forming a photothermographic material as claimed. See the photothermographic material in the abstract, the compound (IV) on page 4, reducing agent on pages 6-11; the polymer latex on page 38, [0099] to [0108], page 39, lines 1-58, page 40, [0113] to [0116], and process for coating the imaging layer on a support on page 46, [0311]. The EP'310 may not disclose the polymer latex that is subjected to purification through desalting step presented in the claimed invention. However, this step is related to the steps of producing of polymer latex that is performed separately from the process of forming the photothermographic

Art Unit: 1752

material, and fails to differentiate the claimed process taught in EP'310. In the absence of showing as how the process of forming the polymer latex affect the process for forming the claimed photothermographic material, it is asserted that the process as claimed is either anticipated or found prima facie obvious over EP'310. The halogen ion presented in the claims is considered as impurity which is inherent to the polymer latex, and there is no utility in the material.

Response to Arguments

10. Applicant's arguments filed November 19, 2004 have been fully considered but they are not persuasive for the reason set forth in the rejections set forth in the paragraph above. The prior art of record teach the process for forming a photothermographic material having steps as claimed such as demonstrated above. The steps of emulsion polymerizing is performed separately from the process of forming a heat-developable material, and fails to differentiate the process of forming a heat-developable material taught in the applied prior art and that claimed in the present claimed invention.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period


Art Unit: 1752

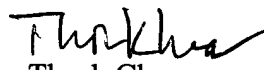
will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thorl Chea whose telephone number is (571) 272-1328. The examiner can normally be reached on 9 AM-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H Kelly can be reached on (571)272-1526. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

tchea 
May 12, 2004


Thorl Chea
Primary Examiner
Art Unit 1752